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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/735,760 | 12/13/2000 | Kazuo Watanabe | SONY-U0200 | 6661 |

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11/15/2005

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/735,760 | Applicant(s) WATANABE, KAZUO | |
| | Examiner Michael Pyzocha | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-10, 13 and 14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-4, 7-10, 13 and 14 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-4, 7-10, and 13-14 are pending.
2. The amendment filed 10/31/2005 has been received and considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5, 7-11, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US 5758069), further in view of Uchenick (US 4458315), and further in view of Coley et al (US 5790664).

Regarding claim 1, Olsen teaches a method of managing software use by a software provider for distribution to a user, comprising the steps of: encoding second information by using a first key of a key pair of an open key encoding format (col. 10 lines 12-26); and transmitting the encoded second information to said software user for said software user to decode said

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transmitted encoded second information by using a second key of said key pair of said open key encoding format (col. 10 lines 12-26, where a digital signature is used to transmit and decode encoded information and col. 12 lines 33-44).

What Uchenick teaches that Olsen doesn't teach is storing inside the software predetermined first information (col. 2 lines 1-8); providing the software to a software user on an information storage means (col. 1 line 67, col. 4 lines 2-4 and 46-51) prepared corresponding to the software and to be connected to an apparatus for running the software, which information storage means is capable of being accessed by the apparatus in a connected state (col. 2 lines 38-43, col. 2 lines 58-60); and to read said first information from said information storage means, and to match said read first information against said decoded second information, wherein said software is enabled when the information match (col. 2 lines 9-16).

It would have been obvious to one of ordinary skill in the art to combine Olsen's electronic licensing system with Uchenick's method for preventing unauthorized use of computer programs in order to provide a more adequate and reliable means of preventing copying of unauthorized use of computer programs, and particularly provide a means which does not depend on the

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good faith of the licensee for its success (Uchenick col. 1 lines 52-57).

Olsen and Uchenick fail to disclose transmitting data to be matched each time the software user uses said software.

However, Coley et al teaches transmitting matching data each time the user uses software (see abstract and column 8 lines 54-67; column 9 lines 1-22, 42-51).

It would have been obvious to one of ordinary skill in the art to combine Coley et al's method of checking with the system of Olsen and Uchenick. Motivation to do so would have been to track the use and to disable invalid software (see abstract).

Regarding claim 2, Olsen, Uchenick, and Coley et al teach a method of managing software use as set forth in claim 1, in addition Olsen teaches receiving predetermined third information identifying the software provided along with said software and said information storage means from the user when said user seeks authorization of use of said software (col. 8 line 64 thru col. 9 line 3, col. 11 lines 33-35); identifying said software user based on said transmitted third information; and detecting second information to be matched against said first information stored in said information storage means given to the software user (col. 11 lines 21-48); detecting second information to be matched against said first information stored in said

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information storage means given to the software user (col. 11 lines 21-48, col. 12 lines 7-19).

Regarding claim 3, Olsen, Uchenick, and Coley et al teach a method of managing software use as set forth in claim 2, in addition Olsen teaches said first information and said second information are selected from the group of information consisting of identification information for identifying said software user, identification information for identifying said distributed software, and identification information for identifying said information storage means (col.5 lines 20-64, col. 9 lines 22-38, col. 10 lines 26-30).

Regarding claim 4, Olsen, Uchenick, and Coley et al teach a method of managing software use as set forth in claim 3, in addition Olsen teaches said first and second information is a password added to said software and said information storage means (col.5 lines 35-42).

Claims 7,13, and 14 are substantially equivalent to claim 1; therefore claims 7,13, and 14 are rejected because of similar rationale.

Claims 8-11 are substantially equivalent to claims 2-7 respectively, therefore claims 8-12 are rejected because of similar rationale.

Response to Arguments

5. Applicant's arguments filed 10/31/2005 have been fully considered but they are not persuasive. Applicant argues that Olsen's license is not matched against anything and therefore Uchenick cannot be combined with Olsen; and Coley fails to make up for the deficiencies of Olsen and Uchenick.

Regarding Applicant's argument that Olsen's license is not matched against anything and therefore Uchenick cannot be combined with Olsen, in column 10 lines 17-24 of Olsen an activation key is taught as part of the secret information included with the license information. The client must also provide this key to activate the software; therefore these keys must be matched to allow for activation. Therefore the matching of keys as taught by Uchenick can be combined with Olsen (and Coley) to obtain the claimed limitations.

Applicant's argument that Coley fails to make up for the deficiencies of Olsen and Uchenick is moot in view of the above response.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

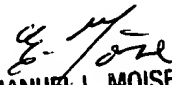
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER